

REMARKS

In the Final Office Action¹ mailed on October 9, 2007, the Examiner refused to consider the remaining documents of the Information Disclosure Statement filed August 25, 2003 ("IDS"); rejected claims 1-7, 10-18, and 21-23 as being unpatentable over U.S. Patent 6,052,788 to Wesinger ("Wesinger") in view of "An IPv6-to-IPv4 Transport Relay Translator" by Hagino et al. ("Hagino"); and rejected claims 8, 9, 19, and 20 as being unpatentable over Wesinger and Hagino, and further in view of U.S. patent 6,779,837 to Bade et al. ("Bade").

Applicant proposes to amend claims 1, 12, and 23. No new matter has been added. Claims 1-23 remain pending. Applicant respectfully requests entry of this Amendment under 37 C.F.R. § 1.116 which places claims 1-23 in a condition for allowance. Applicant submits that this reply does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment should allow for immediate action by the Examiner.

Information Disclosure Statement

The Examiner refuses to consider the remaining references cited in the previously-filed IDS because the "Examiner fails to see how [the outstanding references] have any bearing on the claimed subject matter." Office Action at 2. Regardless of whether Applicant agrees with the Examiner's assertion with respect to the prior art, which Applicant does not, there is no legal basis for refusal to consider the references.

¹ The Office Action contains a number of characterizations of the related art and the claims. Applicant denies to automatically subscribe to any statement or characterization, regardless of whether any such statement or characterization is identified herein.

Applicant respectfully submits that the IDS complies with 37 C.F.R. §§ 1.97-98.

Further, the Examiner has not indicated that IDS is not in compliance with 37 C.F.R. §§ 1.97-98. The Examiner is therefore “*under an obligation to consider the information.*” (Italics added). See MPEP § 609. Indeed, 37. C.F.R. § 1.97(b) states that the references cited by a properly submitted, complaint IDS “*shall be considered.*” (Italics added). *Thus, it is respectfully submitted that the Examiner does not have any discretion as to whether the references cited in a compliant IDS are to be considered.* For these reasons, the references must be considered. 37. C.F.R. § 1.97(b) and MPEP § 609.

For at least the foregoing reasons, Applicant respectfully requests that the Examiner consider each of the remaining outstanding references cited by the IDS by making appropriate notations on the Form PTO/SB08. Applicant requests that a copy of the notated Form be sent along with the next communication.

Rejection of claims 1-7, 10-18, and 21-23 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 1-7, 10-18, and 21-23 as being unpatentable over Wesinger in view of Hagino.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. §2143.01(III) (emphasis in original). “In determining the

differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), (emphasis in original).

Several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. Graham, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; see also KSR Internat'l Co. v. Teleflex Inc., 82 U.S.P.Q.2d 1385 (U.S. 2007); see also M.P.E.P. § 2141(II).

Wesinger and Hagino fail to render obvious claims 1-7, 10-18, and 21-23, as amended, at least because Wesinger and Hagino, taken alone or in combination, do not contemplate all of the features recited in claims 1-7, 10-18, and 21-23.

For example, claim 1 recites a system including a gateway having a firewall process that, among other things,

determines whether a message received from the first off-board module includes a parameter identifier corresponding to one of a number of parameter identifiers included in the

translation table, *the parameter identifiers specifying operational parameters of the first machine.*

Wesinger discloses a firewall system that increases security measures by establishing an envoy to qualify users and/or messages attempting to communicate with hosts protected by the firewall. Wesinger, abstract; and col. 3, ll. 57-66. The firewall of Wesinger includes DNS tables used to translate host names to IP addresses and vice versa (e.g., homer.odyssey.com to 129.186.424.43) to provide transparency between remote hosts. Wesinger, col. 7, ll. 46-53; and col. 10, ll. 3-20. Access to the host is granted, for example, when certain entries are found in the DNS tables. Wesinger, col. 15, ll. 22-33.

While the entries in the DNS tables include IP addresses and host names, these entries do not constitute “parameter identifiers specifying operational parameters of the first machine,” as required by claim 1. That is, IP addresses and host names do not “[specify] operational parameters of the first machine.” Thus, Wesinger does not contemplate a firewall process that “determines whether a message received from the first off-board module includes a parameter identifier . . . included in the translation table, *the parameter identifiers specifying operational parameters of the first machine,*” as recited in claim 1.

Hagino fails to remedy the deficiencies of Wesinger, and the Examiner does not rely on Hagino for such teachings. Office Action at 4. Hagino discloses transport relay translator that translates packets between IPv6 and IPv4, which are two different types of Internet Protocols (IP) known in the art. Hagino at page 1. Specifically, Hagino proposes to reserve an IPv6 prefix in a packet being sent from an IPv6 initiating host to an IPv4 destination host. Hagino at pages 3-4. The packet is sent to, and received by,

a transport relay translator, which makes a IPv4 connection based on the reserved prefix and forwards the packet across the connection. Hagino at page 4.

While Hagino thus facilitates communication between an IPv6 host and an IPv4 destination, Hagino does not contemplate a firewall process that “determines whether a message received from the first off-board module includes a parameter identifier . . . included in the translation table, *the parameter identifiers specifying operational parameters of the first machine,*” as recited in claim 1.

For at least the foregoing reasons, Wesinger and Hagino, taken alone or in combination, do not contemplate the claimed features recited in claim 1. Thus, Wesinger and Hagino fail to disclose or render obvious claim 1. Applicant respectfully requests the withdrawal of the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Wesinger in view of Hagino and the allowance of this claim

Independent claims 12 and 23, although of different scope than claim 1, recite features similar to those discussed above in connection with claim 1. Thus, Wesinger and Hagino fail to disclose or render obvious independent claims 12 and 23. Applicant respectfully requests the withdrawal of the rejection of claims 12 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Wesinger in view of Hagino, and the allowance of these claims.

Claims 2-7, 10, 11, 13-18, 21, and 22 depend from one of claims 1 and 12. Thus, Wesinger and Hagino fail to disclose or render obvious claims 2-7, 10, 11, 13-18, 21, and 22 for at least the same reasons as discussed above in connection with claims 1 and 12. Applicant respectfully requests the withdrawal of the rejection of claims 2-7,

10, 11, 13-18, 21, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Wesinger in view of Hagino, and the allowance of these claims.

Applicant respectfully traverses the rejection of claims 8, 9, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Wesinger and Hagino, and further in view of Bade. As discussed above, Wesinger and Hagino fail to disclose or render obvious independent claims 1, 12, and 23, from which claims 8, 9, 19, and 20 depend. Further, Bade does not remedy the deficiencies of Wesinger and Hagino.

Bade discloses a system that grants or denies access to a mobile electronic device (e.g., cell phone) as it moves from location to location, depending on predefined parameters set by a user and the location of the mobile device at the time access is requested. This feature is used to prevent unauthorized access of the mobile device in locations where legitimate access is not likely to occur, such as in the case of theft or misplacement of the mobile device. Bade, col. 3, ll. 56-61. Bade, however, also does not contemplate the claimed subject matter discussed above in connection with the independent claims.

Claims 8, 9, 19 and 20 depend from one of claims 1 and 12. The cited references therefore fail to disclose or render obvious claims 8, 9, 19, and 20 for at least the same reasons as discussed above in connection with claims 1 and 12. Applicant respectfully requests the withdrawal of the rejection of claims 8, 9, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Wesinger in view of Hagino and Bade, and the allowance of these claims.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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